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10/051,540	01/16/2002	Hiroteru Tsuchiya	02020/LH	9646

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EXAMINER

LIN, WEN TAI

ART UNIT PAPER NUMBER

2154

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/051,540

**Applicant(s)**

TSUCHIYA, HIROTERU

**Examiner**

Wen-Tai Lin

**Art Unit**

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 5 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-18 are presented for examination.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-18 are objected to because the following terms lack antecedent basis:

In claims 1, 6 and 13, "the separate electronic mail";

In claim 6, "the determined group name";

In claims 15 and 18, "the address registration section"; and

In claim 16, "the determined group name".

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-11 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier et al.(hereafter "Olivier") [U.S. 6480885] in view of Official Notice.

5. As to claim 1, Olivier teaches the invention substantially as claimed including: a image communication apparatus [e.g., 346, Fig.3B] which transmits image to a transmission destination address [e.g., col.22, lines 6-10] comprising:

an address storage which stores a mail address [e.g., 348, Fig.3B];

a destination specification acceptance section which accepts specification of any of mail addresses stored in the address storage and determines a specified mail address to be the transmission destination address [e.g., col.3, lines 7-22]; and

an address registration section which stores, in the address storage, a sender's mail address [col.9, lines 18-26].

Olivier does not specifically teach that the registration is done through by sending email (i.e., the mail address is not obtained from the header of a separate electronic mail, upon receipt of electronic mail including specified registration specification information and having a body embedded with separate electronic mail). Rather, the registration as suggested by Olivier is accomplished by entering information into a web page [col.9, lines 30-46].

However, Official Notice is taken that registration by sending email information is a well-known option in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to keep registration by email (i.e., using information contained in a separate mail) as an option, wherein at the sender's mail address can be directly captured from the header of the

mail because (1) Olivier's system is capable of sending subscription information to override the default subscription settings, which has the similar effect of registering through email and (2) the depicted registration via webpage is only an example; Olivier's system is adaptive for variations [col.15, lines 61-64; col.16, lines 56-66; col.26, lines 33-39].

6. As to claim 2, Olivier teaches that the sender's profile data and criteria data, which comprise the registration specification information corresponds to a specified character string, may be included in the body of a message [col.13, lines 43-54]. Olivier does not specifically teach that the specified character string is included in a subject of the electronic mail.

However, Official Notice is taken that it is well known in the art that information contained in the subject line of a mail may be used for specific information (such as canceling subscription membership).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that Olivier's method may use the subject of the email to include designated specification information because it is easier to parse the information carried in the subject field.

7. As to claim 3, Olivier further teaches that the image communication apparatus further comprising:

a received mail processing section which, when electronic mail is received, performs a specified process for the electronic mail [e.g., col.10, lines 62-67; i.e., processing the subscriber match]; and

a deletion section which deletes electronic mail containing the registration specification information without allowing the received mail processing section to perform the specified process [e.g., col.17, lines 21-27].

8. As to claim 4, Olivier further teaches that the image communication apparatus according to claim 1, further comprising:

a specific information storage which stores specific information [e.g., the database portion storing privacy preference - col.14, lines 34-39];

a specific information generation section which generates the specific information by using specified information included in the separate electronic mail [e.g., generate the privacy preference from a request user's mail containing profile and criteria- see 524, Fig.9; note the the privacy preference derived from the mail can override a default setting (see col.16, lines 56-63)], upon receipt of electronic mail including specified registration specification information and having a body embedded with separate electronic mail;

a registration inhibition section which inhibits the address registration section from storing a mail address in the address storage when the specific information storage already stores specific information generated by the specific information generation section [e.g., if the database already confirms the user's privacy preference, then don't use the user's true email address in the mailing-list record (i.e., use an alias instead -- see col.17, lines 65 - col.18, line 4)]; and

a specific information registration section which stores specific information generated by the specific information generation section in the specific information storage only when the

specific information storage does not store the specific information [i.e., if the database does not show privacy preference, then use the user's true email address in the mailing-list record].

9. As to claim 6, since the features of this claim can also be found in claims 1, it is rejected for the same reasons set forth in the rejection of claims 1-4 above.

As for the additional feature requiring the address to store a plurality of mail addresses corresponding a group name: it is noted that Olivier's teaching include forming various groups [col.15, lines 52-61; 522, Fig.9], each has, by default, a unique group name.

10. As to claim 8, Olivier further teaches that the address registration section determines the group name including at least part of a character string indicating a subject of the electronic mail [522, Fig.9].

11. As to claim 9, Olivier further teaches that the address registration section allows the address storage to store all mail addresses indicated in a header of the separate electronic mail [e.g., the group name shown in the "TO" field of Fig.9 has associated with a list mailing addresses in the database].

12. As to claims 7, 10-11 and 13-18, since the features of these claims can also be found in claims 1-4, 6 and 8-9, they are rejected for the same reasons set forth in the rejection of claims 1-4, 6 and 8-9, above.

13. Claims 5 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ogawa et al. [U.S. 20040252336];

SAITO et al. [U.S. 20010040693];

Agraharam et al. [U.S. 5987508];

Ono et al. [U.S. 6742024]; and

Wakasugi et al. [U.S. 6411393].

15. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially



teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:


(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

June 24, 2005

  
6/24/05